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CENTRAL FAX CENTER**

MAR 05 2007

Application No. 10/803,349
Amendment dated March 5, 2007
Reply to Office Action of January 5, 2007

Docket No.: 29617/SH009A

REMARKS

Claims 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 39, 44-46, 49-54, and 78 were examined in a final office action issued on January 5, 2007. Claims 3-6, 8, 13, 17, 19, 22, 23, 25-38, 40-43, 47, 48, 55, and 57-77 stand withdrawn as directed to a non-elected species.

Applicants appreciate the indication that claims 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 39, and 44 are allowed. The specification and claim 45 stand objected to for various informalities. Claim 78¹ stands rejected under 35 U.S.C. § 112, first paragraph, for allegedly lacking written support in the specification. Claims 45, 49-54 and 78 stand rejected as either anticipated by or obvious over one or both of Connors, U.S. Patent No. 6,283,661 and Ross, U.S. Patent No. 2,073,719. Reconsideration and withdrawal of the aforementioned rejections and objections are respectfully requested in view of the foregoing amendments and the following remarks.

By the foregoing, the specification and claims 45, 49, 51, and 78 have been amended. Claims 45 and 78 have been amended to merely clarify subject matter previously examined in the most recent office action. Accordingly, no new search is required, and entry of this amendment is respectfully requested.

Specification Objection

The disclosure stands objected to for an informality regarding an improper reference numeral. Specifically, the office asserts that in paragraph 55, "recess 901" should read "recess 903." The suggested amendment has been made to the specification.

¹ The Office action recites that claim 73 is rejected; however, claim 73 has been withdrawn. Because Claim 78 recites the subject matter noted in the office action, applicants are proceeding with the understanding that the Office intended to reject claim 78, and the reference to claim 73 was a typographical error.

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Claim Objection

Claim 45 stands objected to because the Office action alleges that the claim language "base" should be "dispenser base," and that "housing" should read "dispenser housing." Claim 45 has been amended as suggested. Dependent claims 49 and 51 have been amended to be consistent with claim 45. Claims 53 and 54 have been further amended to improve their antecedent clarity. No change in scope is intended or effected by the foregoing amendments.

Claim Rejections – Written Description

Claim 78 stands rejected under 35 U.S.C. § 112, first paragraph, because the Office action alleges that the recitation of a sealed rear end is considered new matter. The elected embodiment is described as being a writing instrument such as a highlighter. Applicants have amended claim 78 to recite that the writing instrument body portion has a side wall and a rear wall, the rear wall including a recess, and the side wall and the rear wall enclosing a rear end of an ink reservoir. Fig. 10 depicts the side wall and the rear wall of the body 950 and the recess 953 in the rear wall. One of ordinary skill would understand that in a writing instrument such as a highlighter, the side and rear walls enclose a rear end of an ink reservoir. This assertion is corroborated by Fig. 14, which illustrates such a closed end. Furthermore, the examiner implicitly recognizes in the Office action that the elected highlighter includes a closed end. See Office action, pages 2-3. Withdrawal of the rejection to claim 78 for the alleged lack of support in the written description is respectfully requested.

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Claim Rejections – Anticipation

Claims 45 and 49-54 are Allowable

In view of the accompanying amendments to claim 45, applicants respectfully request withdrawal of the rejection to claim 45 as anticipated by each of Connors and Ross. Claim 45 recites that the nub of the dispenser base has a shape that is complementary to the recess of the dispenser housing, such that the sheet material cartridge could be stacked with a similarly configured second sheet material cartridge. Support for this amendment can be found in paragraph 57 of the application. The disclosure teaches that the recess of the writing instrument body portion and the recess of the cartridge have the same dimensions. The disclosure further teaches that the nub of the cartridge can be disposed in, i.e., is complementary to, the recess of the body. It necessarily follows that the nub of the cartridge is complementary to the recess of the cartridge.

Connors fails to disclose that the recess in its housing 12 is complementary to the nub of the base 16. Without any such disclosure, Connors fails to expressly anticipate claim 45. Further, Connors fails to inherently disclose the limitations of claim 45. Inherency can only be relied upon where the disclosed device in a reference MUST include the feature. MPEP § 2112(IV). Here, the nub of the base 16 is not necessarily complementary to the recess on the housing 12. Accordingly, claim 45 is novel over Connors.

Likewise, Ross fails to disclose that the nub of the cartridge is complementary to the cartridge recess. In fact, Fig. 1 of Ross depicts that the asserted nub 12 of Ross has an outside diameter that is greater than the inside diameter of the recess 11. Thus Ross does not disclose or suggest that the nub of the cartridge is complementary to the cartridge recess.

Further, there is no suggestion in either Connors or Ross for the subject matter recited in claim 45, because making the recess complementary to the nub imparts functionality not

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considered in either reference. For example, the user may stack two tape flag cartridges on the back of the highlighter. Further, the user can place a cap of a highlighter either on the back end of the tape flag cartridge, or remove the cartridge altogether and place the cap on the back end of the highlighter itself. Only with the complementary construction of the nub and the recess in the tape flag cartridge itself can the device achieve this type of flexibility.

With respect to the examiner's taking official notice that the structure of the roll of sheet material would have been obvious, the examiner has now stated that Applicants have admitted that the structure of the roll of sheet material is prior art because applicants did not contest this assertion in the last response. However, applicants' previous traversal to the rejection of claim 45 encompassed a traversal to the rejection of all dependent claims. Accordingly, Applicants did not need to reach this issue in their previous response and have not admitted that this disclosure is prior art as suggested by the examiner. Accordingly, claim 45 is allowable over the art of record. Dependent claims 49-54 are allowable for at least the same reasons.

Accordingly, claim 45 is allowable over the art of record. Dependent claims 49-54 are allowable for at least the same reasons.

Claim 78 is Allowable

Applicants respectfully traverse the rejection to claim 78, as amended, over Connors. Claim 78 recites, in part, a writing instrument including a writing instrument body portion having a side wall and a rear wall, the rear wall including a recess, the side wall and the rear wall enclosing a rear end of an ink reservoir.

Connors fails to disclose a writing instrument body portion with a side wall and a rear wall, where the side wall and rear wall enclose a rear end of an ink reservoir. Instead,

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Connors discloses that the writing utensil 14 has an open rear end with connector 16 screwed into the open rear end. Further, the connector 16 itself has an open channel extending throughout its length to accommodate a tube 22 full of ink 24. Furthermore, Connors discloses that the ink tube 22 extends through the open channel of the connector 16, out of the writing instrument body portion and into the housing 12. Accordingly, Connors fails to disclose that the side wall and the rear wall of the body portion 14 enclose a rear end of an ink reservoir as claimed.

By enclosing a rear end of an ink reservoir, the side wall and rear wall allow a user to remove the base from the recess of the rear wall (and exchange the cartridge, for example) without exposing at least a portion of the ink reservoir to ambient atmosphere. When the connector 16 of Connors is removed, a portion of the ink tube 22 is exposed to ambient atmosphere. If the connector is removed for a long enough period, the writing utensil would be subject to dry out, particularly if Connors is adapted for construction of a marker such as a highlighter. In view of these comments, it is respectfully submitted that claim 78 is allowable over Connors. Allowance of claim 78 is respectfully requested.

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CONCLUSION

The applicant respectfully submits that the pending application is in condition for allowance. If, in the opinion of the examiner, a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned attorney.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 13-2855, under Order No. 29617/SH009A/US.

Dated: March 5, 2007

Respectfully submitted,

By 

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